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Siemens Corporation
Intellectual Property Department
3501 Quadrangle Blvd Ste 230
Orlando, FL 32817

EXAMINER
WHITAKER, ANDREW B

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte RAYMOND KOK, IAN FISHER, ERIC LEESON, and ORI BEN-HAIM

Appeal 2016-005975
Application 13/787,992[1]
Technology Center 3600

Before LARRY J. HUME, JOHN D. HAMANN, and SCOTT E. BAIN, *Administrative Patent Judges*.

HUME, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) of the Final Rejection of claims 1–26. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

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[1] According to Appellants, the real party in interest is Siemens Product Lifecycle Management Software Incorporated. App. Br. 4.

STATEMENT OF THE CASE[2]

The Invention

Appellants' disclosed and claimed inventions relate "to computer-aided design, visualization, and manufacturing systems, product lifecycle management ("PLM") systems, and similar systems[] that manage data for products and other items (collectively, "Product Data Management" systems or "PDM" systems)." Spec. ¶ 2.

Exemplary Claims

Claims 1 and 5, reproduced below, are representative of the subject matter on appeal (*emphases* added to contested limitations):

> 1. A system for collaborative virtual product development, comprising:
>
> at least one processor;
>
> a memory connected to the processor;
>
> a collaborative design representing a virtual product, the collaborative design comprising:
>
> *a plurality of design elements stored in the memory, wherein the design elements represent units of data*;
>
> *a plurality of partitions generated by the processor, the partitions defined as a hierarchical organization of the design elements in the collaborative design*; and

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[2] Our Decision relies upon Appellants' Appeal Brief ("App. Br.," filed Oct. 6, 2015); Reply Brief ("Reply Br.," filed May 20, 2016); Examiner's Answer ("Ans.," mailed Apr. 15, 2016); Final Office Action ("Final Act.," mailed May 15, 2015); and the original Specification ("Spec.," filed Mar. 7, 2013).

> *at least one workset generated by the processor, the workset comprising a subset of the design elements possessing membership in the workset based on one or more predetermined rules, the workset configured to enable a user to modify the collaborative design,*
>
> *wherein the processor is configured to search the design elements and operable to generate the subset based on the predetermined rul*es, and wherein the design elements are stored in the memory.

5. The system of claim 1, *wherein the subset is defined by a mutual proximity of the design elements.*

Prior Art

The Examiner relies upon the following prior art as evidence in rejecting the claims on appeal:

Charles et al. ("Charles")	US 2006/0212821 A1	Sept. 21, 2006
Chen et al. ("Chen")	US 2010/0299616 A1	Nov. 25, 2010

Rejections on Appeal

R1. Claims 1–26 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Final Act. 2; Ans. 2.[3]

R2. Claims 1–11, 14–22, 25, and 26 stand rejected under pre-AIA 35 U.S.C. § 102(b) as being anticipated by Charles. Final Act. 4; Ans. 5.[4]

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[3] We note the Examiner characterizes the § 101 Rejection R1 as being a new ground of rejection, even though these claims were previously rejected in the Final Action (2) under § 101. It appears the Examiner has merely restated the rejection in the Answer to be in full accord with current USPTO subject matter eligibility guidelines and the two step *Alice* analysis, discussed *infra*.

R3. Claims 12, 13, 23, and 24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Charles and Chen. Final Act. 7; Ans. 5; *see* n.4.

CLAIM GROUPING

Based on Appellants' arguments (App. Br. 13–98; Reply Br. 10–59) and the Examiner's findings, we decide the appeal of Rejections R1 through R3 based upon the following claim groupings:

Rejection	**Claims**	**Representative Claim**
R1	1–26	1[5]
R2	1, 14, 25, and 26	1[6]
	2 and 15	2
	3 and 16	3
	4 and 17	4
	6 and 18	6
	7 and 19	7

[4] In the Answer, the Examiner corrects an oversight in the Final Action in which claims 13 and 24 were originally stated as being rejected under Rejection R2 without detailed analysis, but which were later rejected in a new ground of rejection in the Answer as being subject to rejection under Rejection R3 along with claims 12 and 24. *Compare* Final Act. 4 *with* Ans. 5.

[5] Although Appellants state each of independent claims 1, 14, 25, and 26 is separately argued under Rejection R1, we note each of the actual arguments presented are commensurate in scope and essentially equivalent to that presented with respect to independent claim 1 such that we group claims 1–26 together. *Compare* App. Br. 18–27 *with* App. Br. 28–35.

[6] Appellants state each of independent claims 1, 14, 25, and 26 is separately argued under Rejection R2. However, we note the actual arguments are commensurate in scope and essentially equivalent to that presented with respect to independent claim 1 such that we group claims 1, 14, 25, and 26 together. *Compare* App. Br. 36–47 *with* App. Br. 63–68 and 80–93.

Rejection	Claims	Representative Claim
R2	8, 9, 20, and 21	8
	10 and 22	10
R3	12 and 23	12
	13 and 24	13

Claims 5 and 11 in Rejection R2 are separately argued by Appellants.

ISSUES AND ANALYSIS

In reaching this decision, we consider all evidence presented and all arguments actually made by Appellants. We do not consider arguments Appellants could have made but chose not to make in the Briefs, and we deem any such arguments waived. 37 C.F.R. § 41.37(c)(1)(iv).

We agree with particular arguments advanced by Appellants with respect to anticipation Rejection R2 of claim 5 for the specific reasons discussed below.

However, we disagree with Appellants' arguments with respect to claims 1–4 and 6–26, and we incorporate herein and adopt as our own: (1) the findings and reasons set forth by the Examiner in the action from which this appeal is taken, and (2) the reasons and rebuttals set forth in the Examiner's Answer in response to Appellants' arguments. We incorporate such findings, reasons, and rebuttals herein by reference unless otherwise noted. However, we highlight and address specific findings and arguments regarding claim 1 for emphasis as follows.

1. § 101 Rejection R1 of Claims 1–26

Issue 1

Appellants argue (App. Br. 18–27; Reply Br. 10–21) the Examiner's rejection of claim 1 under 35 U.S.C. § 101 as being directed to non-statutory subject matter is in error. These contentions present us with the following issue:

Did the Examiner err in concluding claim 1 is directed to a judicial exception, i.e., an abstract idea, without "significantly more" as set forth by the Supreme Court's *Mayo/Alice* analysis framework?[7]

Analysis

Appellants contend independent claims 1, 14, 25, and 26 "are directed to a systems including a processor and memory, which is a machine and therefore a statutory category of invention, to a statutory process, and to a statutory manufacture. The Office Action errs in alleging that the claims are directed to a 'judicial exception.'" Reply Br. 11. Further,

> [I]t is immediately evident that even if the claim did recite a judicial exception, the claim is not attempting to tie up any such exception so that others cannot practice it. Using the Office Action's allegations, it is clear that the instant claims do not attempt to "tie up" either the field of collaborative virtual product development or any "idea" of "gathering and combining data." Thus, eligibility of these claims is self-evident in the streamlined analysis, without needing to perform the full eligibility analysis (e.g., Steps 2A and 2B). These claims are patent eligible.

Reply Br. 11–12 (emphasis omitted).

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[7] *See Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66 (2012) and *Alice Corp. Pty Ltd. v. CLS Bank Int'l*, 134 S. Ct. 2347 (2014).

Section 101 provides that anyone who "invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof" may obtain a patent. 35 U.S.C. § 101. The Supreme Court has repeatedly emphasized that patent protection should not extend to claims that monopolize "the basic tools of scientific and technological work." *Gottschalk v. Benson*, 409 U.S. 63, 67 (1972); *Mayo* 566 U.S. at 71; *Alice*, 134 S. Ct. at 2354. Accordingly, laws of nature, natural phenomena, and abstract ideas are not patent-eligible subject matter. *Id.*

The Supreme Court's two-part *Mayo/Alice* framework guides us in distinguishing between patent claims that impermissibly claim the "building blocks of human ingenuity" and those that "integrate the building blocks into something more." *Id.* (internal quotation marks and bracketing omitted). First, we "determine whether the claims at issue are directed to [a] patent-ineligible concept[]." *Id.* at 2355. If so, we "examine the elements of the claim to determine whether it contains an 'inventive concept' sufficient to 'transform' the claimed abstract idea into a patent-eligible application." *Id.* at 2357 (quoting *Mayo*, 566 U.S. at 72, 79). While the two steps[8] of the *Alice* framework are related, the "Supreme Court's formulation makes clear that the first-stage filter is a meaningful one, sometimes ending the § 101 inquiry." *Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1353 (Fed. Cir. 2016). We note the Supreme Court "has not established a definitive rule to determine what constitutes an 'abstract idea'" for the purposes of step one.

[8] Applying this two-step process to claims challenged under the abstract idea exception, the courts typically refer to step one as the "abstract idea" step and step two as the "inventive concept" step. *Affinity Labs of Tex., LLC v. DIRECTV, LLC*, 838 F.3d 1253, 1257 (Fed. Cir. 2016).

Enfish, LLC v. Microsoft Corp., 822 F.3d 1327, 1334 (Fed. Cir. 2016) (citing *Alice*, 134 S. Ct at 2357).

However, our reviewing court has held claims ineligible as directed to an abstract idea when they merely collect electronic information, display information, or embody mental processes that could be performed by humans. *Elec. Power Grp.*, 830 F.3d at 1353–54 (collecting cases). At the same time, "all inventions at some level embody, use, reflect, rest upon, or apply laws of nature, natural phenomena, or abstract ideas." *Mayo*, 566 U.S. at 71. Under this guidance, we must, therefore, ensure at step one that we articulate what the claims are directed to with enough specificity to ensure the step one inquiry is meaningful. *Alice*, 134 S. Ct. at 2354 ("[W]e tread carefully in construing this exclusionary principle lest it swallow all of patent law").

Under the "abstract idea" step we must evaluate "the 'focus of the claimed advance over the prior art' to determine if the claim's 'character as a whole' is directed to excluded subject matter." *Affinity Labs*, 838 F.3d at 1257 (citation omitted). If the concept is directed to a patent-ineligible concept, we proceed to the "inventive concept" step. For that step we must "look with more specificity at what the claim elements add, in order to determine 'whether they identify an "inventive concept" in the application of the ineligible subject matter' to which the claim is directed." *Affinity Labs*, 838 F.3d at 1258 (*quoting Elec. Power Grp.* 830 F.3d at 1353).

Turning to the claimed invention, claim 1 recites a "system for collaborative virtual product development." Claim 1 (preamble).[9] The

[9] Similarly, independent claims 14, 25, and 26 recite "[a] method for collaborative virtual product development" (claim 14); "[a] data processing

system claim limitations also require a processor and memory, and a collaborative design that includes "design elements," plural "partitions," and at least one "workset" that includes "a subset of the design elements possessing membership in the workset" based upon one or more rules. The processor searches the design elements and generates the subset of the design elements, and the design elements are stored in the memory. Claim 1.

Similarly, the Examiner finds:

> Applicants' claims use a 'at least one processor,' 'memory connected to the processor,' 'a non-transitory computer-readable medium encoded with computer-executable instructions which cause at least one data processing system to . . .' pertaining to an abstract idea itself or the abstract idea of "organizing human activities" involving a collaborative design including a plurality of design elements, partitions and at least one workset. Here, the claimed solution is directed to the abstract idea of "organizing human activities" such as receiving, processing, and storing data (*See Alice Corp.*, 134 S. Ct. at 2360), and electronic record keeping (*See Alice Corp.*, 134 S. Ct. at 2359) i.e. the generation and management of a collaborative design in a memory based on predetermined rules. From the Alice decision, the "organizing human activities" stemmed from the series of steps on how hedge risk i.e. perform activities or steps to analyze data to affect the outcome of a situation. The instant claims simply describe the steps of how to apply the abstract idea on a computer and that these steps are the human activities which are organized.

Ans. 8 (emphasis added).

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system for collaborative virtual product development" (claim 25); and "[a] non-transitory computer-readable medium encoded with computer-executable instructions for collaborative virtual product development." Claim 26.

Under step one, we agree with the Examiner that the inventions claimed in claims 1, 14, 25, and 26 are directed to an abstract idea, i.e., organizing human activities pertaining to a collaborative virtual product design involving receiving, processing, and storing data by using a computer.

As the Specification itself observes, "[t]he present disclosure is directed, in general, to computer-aided design, visualization, and manufacturing systems, product lifecycle management ("PLM") systems, and similar systems, that manage data for products and other items (collectively, "Product Data Management" systems or "PDM" systems)." Spec.¶ 2. We find this type of activity, i.e., managing data for products and other items includes longstanding conduct that existed well before the advent of computers and the Internet, and could be carried out by a human with pen and paper. *See CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1375 (Fed. Cir. 2011) ("That purely mental processes can be unpatentable, even when performed by a computer, was precisely the holding of the Supreme Court in *Gottschalk v. Benson*").[10]

Our reviewing court has previously held other patent claims ineligible for reciting similar abstract concepts. For example, while the Supreme Court has altered the § 101 analysis since *CyberSource* in cases like *Mayo* and *Alice*, they continue to "treat[ ] analyzing information by steps people go through in their minds, or by mathematical algorithms, without more, as essentially mental processes within the abstract-idea category." *Synopsys,*

[10] *CyberSource* further guides that "a method that can be performed by human thought alone is merely an abstract idea and is not patent-eligible under § 101." *CyberSource*, 654 F.3d at 1373.

Inc. v. Mentor Graphics Corp., 839 F.3d 1138, 1146–47 (Fed. Cir. 2016) (quoting *Elec. Power Grp.* 830 F.3d at 1354 (internal quotation marks and citations omitted)).

In applying step two of the *Alice* analysis, our reviewing court guides we must "determine whether the claims do significantly more than simply describe [the] abstract method" and, thus, transform the abstract idea into patentable subject matter. *Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 715 (Fed. Cir. 2014). We look to see whether there are any "additional features" in the claims that constitute an "inventive concept," thereby rendering the claims eligible for patenting even if they are directed to an abstract idea. *Alice*, 134 S. Ct. at 2357. Those "additional features" must be more than "well-understood, routine, conventional activity." *Mayo*, 566 U.S. at 73.

Evaluating representative claim 1 under step 2 of the *Alice* analysis, we agree with the Examiner that it lacks an "inventive concept" that transforms the abstract idea of managing data for products and other items into a patent-eligible application of that abstract idea. Ans. 7. We agree with the Examiner because, as in *Alice*, we find the recitation of a computer processor that searches the design elements and generates a subset of the design elements is simply not enough to transform the patent-ineligible abstract idea here into a patent-eligible invention. *See Alice*, 134 S. Ct. at 2357 ("[C]laims, which merely require generic computer implementation, fail to transform [an] abstract idea into a patent-eligible invention.").

Accordingly, based upon the findings above, on this record, we are not persuaded of error in the Examiner's conclusion that the appealed claims are directed to non-statutory subject matter. Therefore, we sustain the

Examiner's non-statutory subject matter rejection of independent claim 1, and grouped claims 2–26 which fall therewith. *See* Claim Grouping, *supra*.

2. § 102(b) Rejection R2 of Claims 1, 14, 25, and 26

Issue 2

Appellants argue (App. Br. 36–47; Reply Br. 22–36) the Examiner's rejection of claim 1 under 35 U.S.C. § 102(b) as being anticipated by Charles is in error. These contentions present us with the following issue:

Did the Examiner err in finding the cited prior art discloses a "system for collaborative virtual product development" including "a collaborative design representing a virtual product" that includes, *inter alia*,

> [L1] a plurality of design elements stored in the memory, wherein the design elements represent units of data;
>
> [L2] a plurality of partitions generated by the processor, the partitions defined as a hierarchical organization of the design elements in the collaborative design; and
>
> [L3] at least one workset generated by the processor, the workset comprising a subset of the design elements possessing membership in the workset based on one or more predetermined rules, the workset configured to enable a user to modify the collaborative design,
>
> [L4] wherein the processor is configured to search the design elements and operable to generate the subset based on the predetermined rules,

as recited in claim 1 (labeling added)?

Analysis

Limitation L1: Charles Discloses the Claimed "[D]esign [E]lements"

Appellants contend there is no teaching that Charles' "geometrical features" are equivalent to the claimed "design elements," or that such geometrical features "represent units of data", as recited in claim 1. App. Br. 38. Appellants further contend the Examiner improperly took official notice that "'[i]t is old and well known in the computing arts that a rendering or modification of a feature represents a unit of data stored in a computing environment,'" particularly because Charles' disclosed "feature" refers to geometric features. App. Br. 39 (citing Final Act. 9). Appellants also emphasize they traversed the Examiner's taking of official notice during prosecution, without receiving a proper response from the Examiner providing evidence that the claimed feature was well-known in the art. *Id.*

In response to Appellants' arguments, in particular the contention the Examiner improperly invoked official notice, the Examiner finds:

> The Examiner has broadly interpreted, as one of ordinary skill in the art would do, the design elements that represent of units of data as the features of the object i.e. the units of data are the features that make up the entire object which can be isolated for editing thus creating a smaller workspace and piece of data representing that particular feature. The Examiner has only articulated that one of ordinary skill in the art would interpret a rendering or modification of a feature represents a unit of data stored in a computing environment (as shown in ¶ 16 of Charles). Furthermore, the Examiner notes that the rejection of the independent claims 1, 14, 25 and 26 was a proper 102 and that no official notice was taken. Since the Charles reference discloses saving or storing geographical features as data units, which is equivalent to design elements stored in a memory which represent units of data, the reference reads on the claim

> limitations. Still further, the Examiner notes that the specification in paragraph [0004] states "The collaborative design includes a plurality of design elements representing units of data, which include attributes, positions, and geometries of the virtual product," paragraph [0032] wherein "**Design elements 308A-308N, which are also referred to as "design data", may be units of data representing geometry of a part, an object, or an instance**. It will be appreciated that an instance is an occurrence or a copy of an object" and finally paragraph [0064] "The collaborative design includes a plurality of design elements representing units of data, **wherein the units of data define geometries** of the virtual product." Again, one of ordinary skill in the art would have interpreted the geographic features as described by Charles, as the "Design elements 308A–308N, which are also referred to as "design data", may be units of data representing geometry of a part, an object, or an instance" as described by paragraph [0032] of the disclosure.

Ans. 9.

"In the patentability context, claims are to be given their broadest reasonable interpretations . . . limitations are not to be read into the claims from the specification." *In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993) (internal citations omitted). Absent an express intent to impart a novel meaning to a claim term, the words take on the ordinary and customary meanings attributed to them by those of ordinary skill in the art. *Brookhill-Wilk 1, LLC v. Intuitive Surgical, Inc.*, 334 F.3d 1294, 1298 (Fed. Cir. 2003) (internal citation omitted).

We note Appellants have not cited to a definition of "a plurality of design elements . . . [that] represent units of data" in the Specification that would preclude the Examiner's broader reading.[11] Ans. 9.

Accordingly, we agree with the Examiner's finding that Charles discloses contested limitation L1.

Limitation L2: Charles Discloses Hierarchically Organized Partitions

Appellants contend Charles' disclosure that "[d]ata typically include technical data related to the products said data being ordered in a hierarchy of data and are indexed to be searchable" (App. Br. 41 (citing Final Act. 4 and Charles ¶ 8)) teaches "data in a database can be ordered in a hierarchy of data, but does not describe any partitions defined as a hierarchical organization of the design elements ('geometrical features') in the collaborative design, as claimed. There is no such teaching in Charles, and so the anticipation rejection is in error." App. Br. 43 (emphasis omitted).

In response to Appellants' contentions:

> The Examiner notes that the specification states in paragraph [0040]–[0041] "The design elements having membership in function 404 are selected based on their general function while those having membership in area 408 are selected based on their location in a vehicle. It will be appreciated that the design

[11] Any special meaning assigned to a term "must be sufficiently clear in the specification that any departure from common usage would be so understood by a person of experience in the field of the invention." *Multiform Desiccants Inc. v. Medzam Ltd.*, 133 F.3d 1473, 1477 (Fed. Cir. 1998); *see also Helmsderfer v. Bobrick Washroom Equip., Inc.*, 527 F.3d 1379, 1381 (Fed. Cir. 2008) ("A patentee may act as its own lexicographer and assign to a term a unique definition that is different from its ordinary and customary meaning; however, a patentee must clearly express that intent in the written description").

> elements may be partitioned based on many other criteria (e.g., module, system). The partition function 404 contains design elements that are used in chassis 412, powertrain 416, and safety 420. The design elements in powertrain 416 may be further divided into transmission 424 and generation 428. The partition area 408 contains design elements used in front 440, back 444, interior 448, and roof 452. [0041] According to disclosed embodiments, the organization of the in-context design data occurs independently from the physical breakdown through the notion of a partition scheme with associated partitions. Partitions provide a grouping mechanism, which provides a view specific presentation of the in-context design data.

Ans. 10 (emphasis omitted).

In addition:

> The Examiner has broadly interpreted, as one of ordinary skill in the art would do, partitions defined as a hierarchical organization of the design elements as the subsets of features which represent the part or object as disclosed in Charles (i.e. the tree structure will have different levels partitioned off based on that level as it relates to the tree hierarchy of the entire part). Both working examples from the specification and the Charles reference discuss how parts from an automobile are able to be "partitioned" or data displayed in the form of a "tree" wherein an assembly has other parts separated from the larger assembly or grouping. The Examiner notes that as currently claimed, the limitation is broad and does not exclude the use of hierarchal organization of databases which represent parts or objects wherein the parts or objects have subsets of features.

Ans. 10–11.

We agree with the Examiner's findings because, under the broadest reasonable interpretation, the recited "partitions defined as a hierarchical organization of the design elements in the collaborative design" (claim 1)

reads on Charles' disclosure of both functional and locational hierarchies of automobile parts, as set forth by the Examiner. Ans. 11.

Limitation L3: Charles Discloses a Generated Workset as Claimed

Appellants contend:

> Charles does not teach a workset as claimed. The Office Action is correct that Charles describes that each workbench comprises a different subset of software tools — but this does not meet the claim limitation, which requires that a workset comprises a subset of the design elements. Charles does not teach any workset that comprises a subset of the design elements ("geometrical features").

App. Br. 45 (emphasis omitted).

In response, the Examiner finds, and we agree, Charles paragraphs 26 and 70 disclose "a workbench suitable for editing geometrical features of the modeled product." Ans. 11. Further to this point, the Examiner finds Charles paragraph 72 discusses the feature tree of Figure 1 which:

> pertains to a brake assembly including brake caliper and disc. It is the product that breaks out into smaller parts which is equivalent to the workset comprising a subset of design elements (a brake which has a caliper and a disc, the caliper and disc belonging to the brake due to some set of predetermined rules) which is able to be modified, not the subset of software tools as Appellant states.
>
> *Id.*

We agree with the Examiner's interpretation of "workset" set forth above. On this record, Appellants have not shown the Examiner's construction is overly broad, unreasonable, or inconsistent with Appellants' Specification.

Limitation L4: Charles Discloses the Processor Searches the Design Elements and Generates the Claimed Subset

Appellants contend:

> Nothing in the[] paragraphs [of Charles cited by the Examiner] teach or suggest any ability to search the design elements ("geometrical features") — the only thing "indexed to be searchable" is technical data related to products. A general reference to database search capabilities is not the same as the ability to search design elements that represent units of data and are members of worksets based on predetermined rules, as claimed. There is no such teaching in Charles, and so the anticipation rejection is in error.

App. Br. 46–47.

In response to Appellants' contention the *design elements* of Charles are not searchable, the Examiner finds "Charles discloses that users retrieve database information primarily through queries" (Ans. 12), and broadly interprets "the searchable design elements as the ability of users to query using keywords and sorting commands in a database." Ans. 12.

We agree with the Examiner's claim construction and reading of the claim onto the cited prior art.

Accordingly, based upon the findings above, on this record, we are not persuaded of error in the Examiner's reliance on the disclosure of the cited prior art to disclose the disputed limitations of claim 1, nor do we find error in the Examiner's resulting finding of anticipation. Therefore, we sustain the Examiner's anticipation rejection of independent claim 1, and grouped claims 14, 25, and 26. *See* Claim Grouping, *supra*.

3. § 102(b) Rejection R2 of Claim 5

Issue 3

Appellants argue (App. Br. 53–54; Reply Br. 43–44) the Examiner's rejection of claim 5 under 35 U.S.C. § 102(b) as being anticipated by Charles is in error. This contention presents us with the following issue:

Did the Examiner err in finding the cited prior art discloses the system of claim 1, "wherein the subset is defined by a mutual proximity of the design elements," as recited in claim 5?

Analysis

Appellants contend "[t]here is certainly no subset *defined by a mutual proximity of the design elements*, as required by this claim." App. Br. 54 (emphasis added).

We have reviewed paragraph 14 of Charles cited by the Examiner (Final Act. 5) as purportedly disclosing the contested limitation of claim 5, and we find no disclosure, teaching, or suggestion of any such feature where a subset is defined by a mutual proximity of any of the design elements.[12]

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[12] The cited portion of Charles states:

> For example, the user may wish to know where a product, e.g. a braking pedal, is also used, that is, in which other models it is embedded. A standard CAD tools enable a user to navigate between parts or products mainly according to the "is composed of" relation. Databases used in PDM systems enable queries to be made on various types of relation between parts or product and the scope of navigation of the databases is the widest possible. In practice, the user can have access to all the parts, products or assemblies.

Charles ¶ 14.

Accordingly, on this record, we are persuaded the Examiner erred, and, thus, cannot sustain the Examiner's anticipation rejection of dependent claim 5.

4. Rejection R2 of Claims 2–11 and 15–22

While Appellants raised additional arguments (App. Br. 47–62; Reply Br. 36–54) for patentability of separately argued claim 11, and representative claims 2–8 and 10 (*see* Claim Grouping, *supra*), rejected on the same basis as claim 1 under Rejection R2, we find the Examiner has rebutted each of those arguments in the Answer by a preponderance of the evidence, as identified in the following table:

Claims	**Relevant Findings**
2 and 15	Final Act. 5; Ans. 12
3 and 16	Final Act. 5; Ans. 12
4 and 17	Final Act. 5; Ans. 13
6 and 18	Final Act. 5; Ans. 13
7 and 19	Final Act. 5; Ans. 13–14
8, 9, 20, and 21	Final Act. 6; Ans. 14
10 and 22	Final Act. 6; Ans. 14
11	Final Act. 6; Ans. 14–15

Accordingly, we are not persuaded by Appellants' arguments, and we adopt the Examiner's findings and underlying reasoning, which we incorporate herein by reference. Consequently, we find no reversible error in the Examiner's rejection of claims 2–11 and 15–22.

5. Rejection R3 of Claims 12, 13, 23, and 24

While Appellants raised additional arguments (App. Br. 94–97; Reply Br. 55–58) for patentability of representative claims 12 and 13 (*see* Claim Grouping, *supra*), rejected under Rejection R3, we find the Examiner has rebutted each of those arguments in the Answer by a preponderance of the evidence, as identified in the following table:

Claims	**Relevant Findings and Conclusions**
12 and 23	Final Act. 7; Ans. 15
13 and 24	Ans. 5, and 15–16

Accordingly, we are not persuaded by Appellants' arguments, and we adopt the Examiner's findings, underlying reasoning, and legal conclusions which we incorporate herein by reference. Consequently, we find no reversible error in the Examiner's rejection of claims 12, 13, 23, and 24.

REPLY BRIEF

To the extent Appellants may advance new arguments in the Reply Brief (Reply Br. 7–59) not in response to a shift in the Examiner's position in the Answer, we note arguments raised in a Reply Brief that were not raised in the Appeal Brief or are not responsive to arguments raised in the Examiner's Answer will not be considered except for good cause (*see* 37 C.F.R. § 41.41(b)(2)), which Appellants have not shown.

CONCLUSIONS

(1) The Examiner did not err with respect to non-statutory subject matter Rejection R1 of claims 1–26 under 35 U.S.C. § 101, and we sustain the rejection.

(2) The Examiner did not err with respect to anticipation Rejection R2 of claims 1–4, 6–11, 14–22, 25, and 26 under 35 U.S.C. § 102(b) over the cited prior art of record, and we sustain the rejection.

(3) The Examiner erred with respect to anticipation Rejection R2 of claim 5 under 35 U.S.C. § 102(b) over the cited prior art of record, and we do not sustain the rejection.

(4) The Examiner did not err with respect to obviousness Rejection R3 of claims 12, 13, 23, and 24 under 35 U.S.C. § 103(a) over the cited prior art combination of record, and we sustain the rejection.

Because we have affirmed at least one ground of rejection with respect to each claim on appeal, we affirm the Examiner's decision. *See* 37 C.F.R. § 41.50(a)(1).

DECISION

We affirm the Examiner's decision rejecting claims 1–26.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv). *See* 37 C.F.R. § 41.50(f).

AFFIRMED